

REMARKS

Regarding Applicant's Admitted Prior Art (APA), Applicant respectfully asserts that Figure 5 depicts both a prior art clip 13 and a clip 169 constructed in accordance with the present invention. Compare paragraphs 6-7 (prior art) with paragraph 24 (invention). Moreover, Applicant's "Brief Description of the Drawings" on page 5 (paragraph 15) makes it abundantly clear that both types of clips are shown for comparison purposes. That paragraph recites, "a pair of stacked balance clips comparing, on the top, the balance clip of Figure 3 and, on the bottom, a prior art balance clip." Thus, Applicant's clip 169, which includes the end 175 illustrating the smaller radius 179 (Figure 4) and offset distance 181 at which it is formed, is not APA as suggested by the Examiner on Page 2, Paragraph 3 of the present Office Action.

The *Wood* reference discloses clip 34 (Figure 4) having an inner diameter periphery 62 that seats on the outer diameter shoulder 46 (Figure 3) of a ring 26 (Figure 1). Importantly, "the inner periphery 62 of the clip 34 is formed on a diameter that is slightly smaller than the shoulder 46 on the clamp ring 26." Col. 6, lines 24-26. This means that clip 34 contracts radially inward to make contact with the exterior of shoulder 46, which is the opposite of Applicant's design to expand the clip outward to the interior of the balance clip holder. *Wood's* clip 34 also lacks a bent tab and its opposite end is not offset. Rather, the inner periphery 62 of *Wood* is formed on a single diameter to make good contact with shoulder 46. Thus, the ends of clip 34 are formed on the same diameter, and neither end has a bent tab. As a result, both ends of clip 34 clearly make contact with shoulder 46.

Applicant's claims readily distinguish the cited references based on these differences. For example, Claim 1 requires "offsetting an opposite end of the balance clip relative to a body of the balance clip." As fully explained and supported above, Applicant's APA does not show this (it is part of the present invention), and *Wood's* inner periphery 62 is formed at a single diameter with

no offset whatsoever. In addition, Claim 1 states that "the opposite end is free of contact with the balance clip holder." The APA clearly shows the opposite end contacting the holder, and *Wood's* clip shows both of its ends in contact with and "gripping the shoulder 46" (col. 6, line 28; Figures 6 and 7). Thus, Claim 1 is not anticipated by the APA or *Wood* and now is in condition for allowance.

Claims 2-5 depend from Claim 1 and are allowable for the same reasons as Claim 1. In addition, each of the claims require additional elements that further distinguish the prior art. For example, Claim 2 requires the offsetting step to comprise "forming the opposite end of the balance clip at a radius that is less than a radius of the body of the balance clip." As described above, both the APA and *Wood* show clips with constant diameters. Moreover, *Wood* grips radially inward and does not expand radially outward like Applicant's invention. Furthermore, if *Wood's* opposite end did have a smaller radius, it would further scratch its shoulder which would generate even more debris for contaminating the disk drive. It is clearly antithetical for *Wood* to provide such a design.

Claim 3 states that the offsetting step comprises "forming the opposite end of the balance clip at a pre-determined lesser radial distance with respect to the body of the balance clip." The same reasoning applied to Claim 2 applies to this claim as well. Finally, Claim 5 requires the opposite end of the balance clip to be "free of contact with an outer diameter wall of the balance clip holder." Since both the APA and *Wood* show contact between their respective clips and clip holders, and *Wood* contacts an inner diameter wall (shoulder 46), Claim 5 is readily distinguished over the prior art.

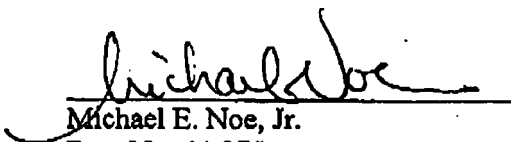
Like Claim 1, independent Claim 6 requires the step, "offsetting an opposite end of the balance clip," but adds that it is offset "radially inward relative to a diameter of a body of the balance clip." Claim 6 also requires the opposite end of the balance clip to be "free of contact

with an outer diameter wall of the balance clip holder." For the reasons previously described, Claim 6 and its progeny are not anticipated by the prior art and are in condition for allowance.

New Claim 9 states that the "balance clip holder in the motor hub having a radially inward-facing shoulder," and the clip is "seated in and expanded radially outward into the outer diameter shoulder." *Wood's* shoulder 46 faces radially outward and its clip collapses radially inward. Claim 9 also requires "offsetting an opposite end of the balance clip radially inward relative to a diameter of a body of the balance clip," and that "the opposite end of the balance clip is free of contact with the outer diameter wall of the balance clip holder." Claim 9 is allowable over the prior art for each of the elements.

It is respectfully submitted that the claims are in condition for allowance and favorable action is requested. No fee for an extension of time or other fees are believed to be required. However, in the event that one or more fees are required, please charge them to Hitachi Global Storage Technologies' Deposit Account Number 50-2587.

Respectfully submitted,


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